



REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed April 22, 2005. Reconsideration and allowance of the application and presently pending claims, as amended, are respectfully requested.

1. Response to Rejection of Claims 1, 4, 7, 9, 28, and 31 Under 35 U.S.C. § 102(b)

Claims 1, 4, 7, 9, 28, and 31 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Hirst* (U.S. Pat. No. 5,930,553). Applicants respectfully traverse this rejection.

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the *Hirst* reference. Applicants discuss the *Hirst* reference and Applicants’ claims in the following.

a. Claim 1

As provided in independent claim 1, Applicants claim:

A flexible printing system comprising:
a printer comprising memory that stores a set of updateable print characteristics and a print characteristics transfer mechanism; and
a printer consumable comprising memory that stores a set of print characteristics, the printer consumable coupled to the print characteristics transfer mechanism in order to update the set of updateable print characteristics in the printer memory, ***wherein the updateable characteristics include finishing processes.***

(Emphasis added).

Applicants respectfully submit that independent claim 1 is allowable for at least the reason that *Hirst* does not disclose, teach, or suggest at least the feature “wherein the updateable characteristics include finishing processes,” as recited and emphasized above in claim 1.

Claim 1 has been amended to include the feature previously disclosed in claim 10. Since the Office Action acknowledges that *Hirst* fails to disclose at least the feature “wherein the updateable characteristics include finishing processes,” *Hirst* fails to anticipate claim 1, and the rejection under 35 U.S.C. § 102(e) should be withdrawn. However, the Office Action alleges that the proposed combination of *Hirst* in view of *Bullock* (U.S. Patent No. 5,835,817) discloses the claimed feature in the rejection for claim 10. Applicants respectfully traverses this finding.

Bullock discloses at most that “data can be stored in a memory chip 40 which enables more accurate control in response to developer module parameters.” *Bullock* also provides examples where a color saturation level is adjusted based upon the temperature of fuser rollers and toner-to-carrier ratio is adjusted based upon the sensor offset in order to obtain more accurate control and adjustments of printer settings, which are not examples of finishing processes. Col. 5, lines 12-31: Therefore, *Bullock* fails to teach or suggest “wherein the updateable characteristics include finishing processes.”

Therefore, claim 1 is patentable over the cited art, and the rejection should be withdrawn for at least this reason alone.

b. Claims 4, 7, and 9

Because independent claim 1 is allowable over the cited art of record, dependent claims 4, 7, and 9 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that the dependent claims 4, 7, and 9 contain all the elements and features of independent claim 1. For at least this reason, the rejection of claims 4, 7, and 9 should be withdrawn.

c. Claim 28

As provided in independent claim 28, Applicants claim:

A printer cartridge apparatus having a capability for printing on media and updating printing characteristics of a printer, the apparatus comprising:

memory that stores printing characteristics for use by the printer;

means for transferring the printing characteristics to the printer, the means coupled to the memory; and

means for printing on the media, *wherein the printing characteristics include finishing parameters.*

(Emphasis added).

Applicants respectfully submit that independent claim 28 is allowable for at least the reason that *Hirst* does not disclose, teach, or suggest at least the feature “wherein the updateable characteristics include finishing processes,” as recited and emphasized above in claim 28.

Claim 28 has been amended to include the feature previously disclosed in claim 32. Since the Office Action acknowledges that *Hirst* fails to disclose at least the feature “wherein the updateable characteristics include finishing processes,” *Hirst* fails to anticipate claim 28, and the rejection under 35 U.S.C. § 102(e) should be withdrawn. However, the Office Action alleges that the proposed combination of *Hirst* in view of *Bullock* (U.S. Patent No. 5,835,817) discloses the claimed feature in the rejection for claim 32. Applicants respectfully traverses this finding.

For example, *Bullock* discloses at most that “data can be stored in a memory chip 40 which enables more accurate control in response to developer module parameters.” *Bullock* provides examples where a color saturation level is adjusted based upon the temperature of fuser rollers and toner-to-carrier ratio is adjusted based upon the sensor offset in order to obtain more accurate control and adjustments of printer settings, which are not examples of finishing processes. Col. 5, lines 12-31. Therefore, *Bullock* fails to teach or suggest “wherein the updateable characteristics include finishing processes.”

Therefore, claim 28 is patentable over the cited art, and the rejection should be withdrawn for at least this reason alone.

d. Claim 31

Because independent claim 28 is allowable over the cited art of record, dependent claim 31 (which depends from independent claim 28) is allowable as a matter of law for at least the reason that the dependent claim contains all the elements and features of independent claim 28. For at least this reason, the rejection of claim 31 should be withdrawn.

2. Response to Rejection of Claims 22-25 Under 35 U.S.C. § 102(e)

Claims 22-25 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Brot* (U.S. Pat. No. 6,522,348). Applicants respectfully traverse this rejection.

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the *Brot* reference. Applicants discuss the *Brot* reference and Applicants’ claims in the following.

a. Claim 22

As provided in independent claim 22, Applicants claim:

A flexible printing system comprising:
a printer comprising:
memory that stores updateable printing characteristics; and
a print characteristics transfer mechanism;
a network connection that enables the printer to access a
network; and
***a printer data memory that stores a uniform resource locator,
the printer data memory coupled to the print characteristics transfer
mechanism in order to transfer the uniform resource locator to the
printer.***

(Emphasis added).

Applicants respectfully submit that independent claim 22 is allowable for at least the reason that *Brot* does not disclose, teach, or suggest at least the feature of “a printer data memory that stores a uniform resource locator, the printer data memory coupled to the print characteristics transfer mechanism in order to transfer the uniform resource locator to the printer,” as recited and emphasized above in claim 22.

While *Brot* discloses at most a “chip 4 that sends on-line the call number of the server and then, communication having been established, the chip transmits data to the server identifying the type of cartridge, such as a reference number.” Col. 3, lines 5-9 (Emphasis added). Therefore, *Brot* fails to teach or suggest “a printer data

memory that stores a uniform resource locator, the printer data memory coupled to the print characteristics transfer mechanism in order to transfer the uniform resource locator to the printer,” as recited and emphasized above in claim 22.

Accordingly, claim 22 is not anticipated by *Brot*, and the rejection should be withdrawn for at least this reason alone.

b. Claim 23-25

Because independent claim 22 is allowable over the cited art of record, dependent claims 23-25 (which depend from independent claim 22) are allowable as a matter of law for at least the reason that the dependent claims contain all the elements and features of independent claim 22. For at least this reason, the rejection of claims 23-25 should be withdrawn.

3. Response to Rejection of Claims 2 and 12-18 Under 35 U.S.C. § 103(a)

Claims 2 and 12-18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hirst* in view of *Wheeler* (U.S. Patent No. 6,467,888). Applicants respectfully traverse this rejection.

a. Claim 2

As noted above, claim 1 is allowable over *Hirst* and *Bullock*. Furthermore, Applicants finds nothing in *Wheeler* to remedy the deficiencies of *Hirst* and *Bullock* regarding the claim 1 element of “updateable characteristics include finishing processes”. Therefore, claim 2 which depends from claim 1 is also allowable.

b. Claims 12-18

As provided in independent claim 12, Applicants claim:

A flexible printing system comprising:
a printer comprising programmable memory that stores updateable print characteristics and a radio frequency receiver; and
a printer consumable comprising memory that stores a set of printer characteristics and a radio frequency transmitter that transmits the printer characteristics to the radio frequency receiver, ***wherein the updateable characteristics include finishing processes.***

(Emphasis added).

In the present case, the cited art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the cited art to modify the references to include those limitations. For example, neither *Hirst* nor *Wheeler* teaches or suggests “wherein the updateable characteristics include finishing processes,” as recited in claim 12. Further, as previously discussed, the other cited references also fail to disclose at least this claimed feature.

Therefore, a prima facie case establishing an obviousness rejection has not been made. Thus, claim 12 is not obvious in view of the cited references, and the rejection should be withdrawn for at least this reason alone. Likewise, the rejections of claims 12-18 should be withdrawn for similar reasons.

4. Response to Rejection of Claims 3, 5, and 6 Under 35 U.S.C. § 103(a)

Claims 3, 5, and 6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hirst* in view of *Arthur* (U.S. Patent No. 5,049,898). Applicants respectfully traverse this rejection.

As noted above, claim 1 is allowable over *Hirst* and *Bullock*. Furthermore, Applicants finds nothing in *Arthur* to remedy the deficiencies of *Hirst* and *Bullock* regarding the claim 1 element of “updateable characteristics include finishing processes”. Therefore, claims 3, 5, and 6 which depend from claim 1 is also allowable.

5. Response to Rejection of Claims 8, 29, and 30 Under 35 U.S.C. § 103(a)

Claims 8, 29, and 30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hirst*. Applicants respectfully traverse this rejection.

Because independent claims 1 and 28 are allowable over the cited art of record, respective dependent claims 8, 29, and 30 (which depend from independent claims 1 and 28) are allowable as a matter of law for at least the reason that the respective dependent claims contain all the features of independent claims 1 and 28. For at least this reason, the rejection of claims 8, 29, and 30 should be withdrawn.

6. Response to Rejection of Claims 10, 11, and 32 Under 35 U.S.C. § 103(a)

Claims 10, 11, and 32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hirst* in view of *Bullock* (U.S. Patent No. 5,835,817).

a. Claims 10 and 32

Without addressing the validity of the rejection, claims 10 and 32 have been canceled without prejudice, waiver, or disclaimer, and therefore the rejection has been rendered moot. Applicants reserve the right to pursue the subject matter of these claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the canceled subject matter to the public.

b. Claim 11

Because independent claim 1 is allowable over the cited art of record, dependent claim 11 (which depends from independent claim 1) is allowable as a matter of law for at least the reason that the dependent claim contains all the elements and features of independent claim 1. For at least this reason, the rejection of claim 11 should be withdrawn.

In addition, the cited art does not teach or suggest all of the limitations of claim 11, and there is no suggestion or motivation in the cited art to modify the references to include those limitations. For example, neither *Hirst* nor *Bullock* teaches or suggests “wherein the finishing processes include a matte finish, a glossy finish, a satin finish, and finishes with varied surface roughness,” as recited in claim 11. Therefore, a prima facie case establishing an obviousness rejection by *Hirst* in view of *Bullock* has not been made for at least this reason. Thus, claim 11 is not obvious under the proposed combination of *Hirst* in view of *Bullock*, and the rejection should be withdrawn for at least this reason alone.

7. Response to Rejection of Claims 20, 21, 26, and 27 Under 35 U.S.C. § 103(a)

Claims 20, 21, 26, and 27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hirst* in view of *Brot*. Applicants respectfully traverse this rejection.

As provided in independent claim 20, Applicants claim:

A method for updating printing characteristics in a printing system comprising a printer having a card reader and a first set of

printing characteristics and a data card that stores a second set of printing characteristics, the method comprising the steps of:
 coupling the data card to the card reader;
 the printer reading the second set of printing characteristics from the data card;
 if the second set of printing characteristics are different from the first set of printing characteristics, the printer retrieving the second set of printing characteristics from the data card; and
 updating the first set of printing characteristics with the second set of printing characteristics, *wherein the second set of printing characteristics include finishing processes.*

(Emphasis added).

In the present case, the cited art does not teach or suggest all of the limitations of claim 20, and there is no suggestion or motivation in the cited art to modify the references to include those limitations. For example, neither *Hirst* nor *Brot* teaches or suggests "wherein the updateable characteristics include finishing processes," as recited in claim 20. Further, as previously discussed, the other cited references also fail to disclose at least this claimed feature.

Therefore, a prima facie case establishing an obviousness rejection has not been made. Thus, claim 20 is not obvious in view of the cited references, and the rejection should be withdrawn for at least this reason alone. Likewise, the rejections of claims 21, 26, and 27 should be withdrawn for similar reasons.

8. Lack of Factual Findings

Applicant respectfully traverses the finding in the Office Action, with regard to claims 8, 11, 16, 18, 27, 29, and 30 of Official Notice and claims 2, 3, 5, 6, 8, 11, 12, 13, 16, 18, 20, 21, 26, 27, 29, and 30 with regard to findings of well-known art.


Per MPEP 2144.03(A), "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." Also, per MPEP 2144.03(B), "If such notice is taken, the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge."

Furthermore, any and all findings of well-known art similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. As specific factual findings predicated on sound technical and scientific reasoning in support of the conclusion of common knowledge are not provided in the Office Action, the rejections should be withdrawn.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,


Charles W. Griggers
Reg. No. 47,283